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Casimir Jones, S.C. 2275 DEMING WAY, SUITE 310 MIDDLETON, WI 53562				
EXAMINER				
CLEMENT, MICHELLE RENEE				
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/579,119

**Applicant(s)**

SAMMUT ET AL.

**Examiner**

Michelle (Shelley) Clement

**Art Unit**

3641

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 22 July 2010.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-72 is/are pending in the application.
- 4a) Of the above claim(s) 11, 15, 20-30, 60-63, 67 and 69 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/GS/US)
- 4) ☐ Interview Summary (PTO-413)
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_
- Paper No(s)/Mail Date \_\_\_\_\_

## **DETAILED ACTION**

### ***Election/Restrictions***

1. Claims 11, 15, 20-30, 60-63, 67 and 69 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on 7/22/10.

### ***Information Disclosure Statement***

2. The listing of references in the specification is not a proper information disclosure statement. 37 CFR 1.98(b) requires a list of all patents, publications, or other information submitted for consideration by the Office, and MPEP § 609.04(a) states, "the list may not be incorporated into the specification but must be submitted in a separate paper." Therefore, unless the references have been cited by the examiner on form PTO-892, they have not been considered.

### ***Double Patenting***

3. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225

USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

4. Claims 1-20 and 70-72 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1 and 11-13 of U.S. Patent No. 7,832,137. Although the conflicting claims are not identical, they are not patentably distinct from each other because the application claims are generic to all that is recited in the patented claims. In other words, the patent claims fully encompass the subject matter of the application claims and therefore anticipate the application claims. Since the application claims are anticipated by the patent claims, they are not patentably distinct. Thus the invention of the patent is in effect a "species" of the "generic" invention of the application claims. It has been held that the generic invention is anticipated by the species, see *In re Goodman*, 29 USPQ2d 2010 (Fed. Cir. 1993). Since the application claim is not patentably distinct from the patent claim, regardless of any additional subject matter present in the patent claims.

5. Claims 1 and 6-10 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-16 of U.S. Patent No. 6,516,699. Although the conflicting claims are not identical, they are not patentably distinct from each other because substantially all elements specifically claimed in the patent are present in the same or a broader sense in the current application.

### *Specification*

6. The lengthy specification has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification.

1. The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Where the written description only implicitly or inherently sets forth the structure, materials, or acts corresponding to a means-plus-function, applicant must clarify the disclosure to explicitly state, with reference to the terms and phrases of the claim element, what structure, materials, or acts perform the function recited in the claim elements and equivalents thereof. (See MPEP 2181). Correction of the following is required: applicant must clarify the disclosure to explicitly state, with reference to the terms and phrases of the claim element, what structure, materials, or acts perform the means for mounting the housing recited in the claim elements and equivalents thereof.

7. The attempt to incorporate subject matter into this application by reference to William Davis, American Rifleman, March, 1989 is ineffective because an application for a patent may incorporate "essential material" by reference to (1) a U.S. patent, or (2) a U.S. patent application publication, or (3) a pending U.S. application, which patent or patent application publication

does not itself incorporate such essential material by reference. Applicant is required to supply a copy of the material incorporated by reference. See MPEP 608.01(p) A.

8. An issue of public use or on sale activity has been raised in this application. In order for the examiner to properly consider patentability of the claimed invention under 35 U.S.C. 102(b), additional information regarding this issue is required as follows: The ballistic calculator system was first described in application 10/706184 having a filing date 11/12/03, appears to be the same as the disclosed prior art TRAG programs, which were in public use or on sale prior to 11/12/03. Applicant is required to submit information requiring all TRAG programs, the dates released, and any differences between the TRAG program and the current invention. Applicant and the assignee of this application are required under 37 CFR 1.105 to provide the following information that the examiner has determined is reasonably necessary to the examination of this application.

Applicant is reminded that failure to fully reply to this requirement for information will result in a holding of abandonment.

9. Applicant and the assignee of this application are required under 37 CFR 1.105 to provide the following information that the examiner has determined is reasonably necessary to the examination of this application.

10. The information is required to complete the background description in the disclosure by documenting the Ballistics program written by William C. Davis of Tioga Engineering. In response to this requirement, please state the specific improvements of the subject matter in claims 1-21 over the disclosed prior art and indicate the specific elements in the claimed subject matter that provide those improvements.

11. In response to this requirement, please provide a copy of each of the following items of art referred to in the William Davis, American Rifleman, March, 1989.

12. In responding to those requirements that require copies of documents, where the document is a bound text or a single article over 50 pages, the requirement may be met by providing copies of those pages that provide the particular subject matter indicated in the requirement, or where such subject matter is not indicated, the subject matter found in applicant's disclosure.

13. The fee and certification requirements of 37 CFR 1.97 are waived for those documents submitted in reply to this requirement. This waiver extends only to those documents within the scope of this requirement under 37 CFR 1.105 that are included in the applicant's first complete communication responding to this requirement. Any supplemental replies subsequent to the first communication responding to this requirement and any information disclosures beyond the scope of this requirement under 37 CFR 1.105 are subject to the fee and certification requirements of 37 CFR 1.97.

14. The applicant is reminded that the reply to this requirement must be made with candor and good faith under 37 CFR 1.56. Where the applicant does not have or cannot readily obtain an item of required information, a statement that the item is unknown or cannot be readily obtained may be accepted as a complete reply to the requirement for that item.

15. This requirement is an attachment of the enclosed Office action. A complete reply to the enclosed Office action must include a complete reply to this requirement. The time period for reply to this requirement coincides with the time period for reply to the enclosed Office action.

***Claim Objections***

16. Claim 70 is objected to because of the following informalities: line (b) recites "aim 1", which should apparently be --claim 1--. Appropriate correction is required.

***Claim Rejections - 35 USC § 112***

17. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 64-67 and 70-72 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The "**means** for mounting" was not expressly disclosed in the specification at the time the application was filed.

18. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

19. Claims 1-10, 12-14, 16-19, 31-59, 64-66, 68 and 70-72 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

It is required that all claimed elements have clearly defined structural relationships. Therefore, the processor and the ballistics computer program must be related to all other elements which are claimed. In claim 1, it is not clear if the claimed processor is a computer or if a computer is required for the "computer program". In claim 1, it is not clear what comprises "external conditions" and to what they are external. In claim 1, (f),



- it is not clear what comprises "the relation of the shooter and the target". Is it directional, distance, velocity or some combination of parameters which is being claimed? In claim 1, (f), the phrase "**can be** greater than 1000 yards" is vague and indefinite since it is not clear if the limitation of greater than a 1000 yards is being claimed.
20. In Claim 31, (c) "said cross-hair" is indefinite in that primary cross-hairs and secondary cross-hairs have been previously recited, it is not clear which cross-hairs applicant is referencing.
21. In Claim 44, "said cross-hair" is indefinite in that primary cross-hairs and secondary cross-hairs have been previously recited, it is not clear which cross-hairs applicant is referencing.
22. In Claim 64, (e)(3), "said cross-hair" is indefinite in that primary cross-hairs and secondary cross-hairs have been previously recited, it is not clear which cross-hairs applicant is referencing.
23. Claim 68 rejected under 35 U.S.C. 112, second paragraph, as being incomplete for omitting essential steps, such omission amounting to a gap between the steps. See MPEP § 2172.01. The omitted steps are: the ballistics calculator system providing any aiming points such that one or more may be selected.
24. In Claim 70, (a)(5)(ii)(second occurrence), "said cross-hair" is indefinite in that primary cross-hairs and secondary cross-hairs have been previously recited, it is not clear which cross-hairs applicant is referencing.
25. Claims 70-72 are rejected under 35 U.S.C. 112, second paragraph, as being incomplete for omitting essential steps, such omission amounting to a gap between the steps. See MPEP § 2172.01. The omitted steps are: the target acquisition device providing an aiming point such that one may be selected.

***Claim Rejections - 35 USC § 102***

26. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

27. Claims 1-10, 12-14, 16-19, 31-52, 54-59 and 68 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Heidmann et al. (US Patent # 4,671,165). Heidmann et al disclose a ballistics calculator system comprising all claimed elements including a computer processor 101 with a program for analyzing information to accurately aim an attached firearm; an optical sighting device 120 with lenses 121, 128 and a cross-hair reticle 1; means 102, 103, 107, to provide parameters to the program; and a display means 105. Also, a detector 111 of ambient light regulates the display and background so, without further limitations to the claims, this is considered to anticipate "an illuminated night vision device" since it is illuminated and can be used in at least some degree of "night". Heidmann et al. further discloses the specific reticle indicating rate of movement of a target.

28. Claims 1-10, 12-14 and 16-19 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by admitted prior art TRAG1S program, ATRAG program and other TRAG programs, herein referred to as TRAG. TRAG was on sale or in public use as early as 2001, and it appears that the current program claimed is the same as that which was on sale or in public use (See Advertisement--Precision Shooting--April 2001 as submitted by applicant in parent application 10/706,184). In ¶ 0158 applicant states that the ballistic calculator program of the present invention is the 'TRAG1S program' family, the 'ATRAG program' family and other

'TRAG programs'; it appears that the prior art TRAG programs disclose all that is claimed in claims 1-10, 12-14 and 16-19.

29. Claims 1-10, 12-14 and 16-19 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by CheyTac (Technology over Tradition--Technical White Papers, 2001-2003, 09/26/01). CheyTac discloses the claimed ballistics calculator system for computing targeting information comprising all claimed elements.

30. Claims 1-10, 12-14, and 16-19 are rejected under 35 U.S.C. 102(b) as being anticipated by Perry-Systems (Using Exbal on the Palm Hand Held, 9/19/02. Advertisement as submitted by applicant in parent application 10/706,184). Perry-Systems discloses the claimed ballistics calculator system for computing targeting information comprising all claimed elements.

***Claim Rejections - 35 USC § 103***

31. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

32. Claim 53 is rejected under 35 U.S.C. 103(a) as being unpatentable over Heidmann et al. as applied to claims 1 and 31 above, and further in view of Wascher et al. (US Patent # 5,491,546). Although Heidmann et al. does not expressly disclose the reticle comprising a ring positioned optically between the optical center and the edge, the ring spaced from the edge and circumscribing the optical center and one or more aiming points, Wascher et al. does. Wascher et al. teaches a telescopic target sighting system comprising a reticle comprising a substantially transparent disc having an optical center and an edge for mounting the disc and a ring in order to

tell a relative size of target (See figures 13-15). All the component parts are known in the references. The only difference is the combination of the "old elements" into a single device. Thus it would have been obvious to one having ordinary skill in the art to include the optical ring taught by Wascher et al. onto the reticle as shown in Heidmann et al, since the operation of a optical ring is in no way dependent on the operation of the other equipment of the reticle, and an optical ring could be used in combination with a standard reticle to achieve the predictable results of visually determining the size of a target.

33. Claims 64-66 and 70-72 are rejected under 35 U.S.C. 103(a) as being unpatentable over Heidmann et al. as applied to claim 1 above, and further in view of Rubbert (US Patent # 3,948,587). Although Heidmann et al. does not expressly disclose the ballistic calculator system comprising wherein the target acquisition device comprises a housing, a mount, an objective and ocular lens, Rubbert does. Rubbert teaches a target acquisition device comprising a housing, a mount and objective and ocular lens comprising variable power optics which operate in the first focal plane. All the component parts are known in the references. The only difference is the combination of the "old elements" into a single device. Thus it would have been obvious to one having ordinary skill in the art to include the housing, mount, objective and ocular lens onto the target acquisition device as shown in Heidmann et al, since the operation of these elements are in no way dependent on the operation of the other equipment of the ballistics calculator system, and a housing, mount, and lens could be used in combination with a standard ballistics calculator system to achieve the predictable results of allowing variable optical power without disturbing the reticle position.

***Conclusion***

34. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michelle (Shelley) Clement whose telephone number is 571.272.6884. The examiner can normally be reached on Monday thru Thursday 9-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Carone can be reached on 571.272.6873. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Michelle (Shelley) Clement/  
Primary Examiner, Art Unit 3641